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IBM Corporation Intellectual Property Law 2455 South Road, P386 Poughkeepsie, NY 12601				
EXAMINER				
HICKS, MICHAEL J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,205

Applicant(s)

MERENDA ET AL.

Examiner

Michael J. Hicks

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-15 and 46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-2, 4-15 and 46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 2, 4-15, and 46 Pending.
Claims 3 and 16-45 Canceled.

Response to Arguments

2. Applicant's arguments filed 7/31/2008 have been fully considered but they are not persuasive.

As per Applicants arguments that the prior art of record not disclose or render obvious the feature, as described in Claim 1, of providing a user with a logical link to a private data set, and using that logical link to give that user access to selected data in a private data set, where that selected data enables the user to contact a given person, Examiner respectfully disagrees. As shown in the amended rejection, this limitation is clearly disclosed by the art of Ewing as shown below.

As per Applicants arguments on Page 8, regarding the deficiencies of l'Etraz, Examiner notes that the indicated deficiencies are disclosed by the art of Ewing, as noted by Applicant on Page 9 of the Applicants remarks.

As per Applicants arguments on Page 9 of Applicants remarks regarding Ewing not disclosing the limitation that the data in the public record and the data in the private record come from the same source, Examiner respectfully disagrees. As noted in the

previous office action, Paragraph 47 of Ewing clearly discloses this limitation. Examiner notes that while the public and private data records may be accessed by a second party, the information contained in the records do come from the same source (e.g. the giftee), the indicator of this being that the data is assigned to the particular giftee.

As per the above arguments, the rejection will be updated to reflect amendments made to the claims and maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-5, 10-15, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (US 6,073,138) in view of Ewing (US 2002/0095298 A1).

As per claim 1 de l'Etraz et al. is directed to accessing data records in a private data set having restricted access, the records in the private data set being accessible only by authorized users (column 5, lines 61-62), the method comprising the steps of:

separating a data record having a defined set of data about a given person into a public data record stored in a public data set and a private data record stored in a

private data set, said public data record having a first, public subset of the set of data about the given person, and the private data record having a second, private subset of the set of data about the given person (figure 1a, elements 102a and 104a)

creating a logical link (column 10, lines 47-65, wherein both databases are relational databases which are organized into relational tables and as such are logically linked, by use of ownerID)

receiving a request from the user to perform a predefined operation using information from the private data record, the request comprising information from the public data record and said logical link, the user not having read access all of the private data set (column 5, lines 52-56);

in response to said request, finding the private data record using the information from the public data record received from the user in combination with the logical link (column 5, 55-63);

and performing the predefined operation using the private data record (column 5, lines 55-59).

de l'Etraz et al. does not teach to provide access to the private data record from the public data record, said access enabling use of said private data record without providing read access to the private record, including the step of putting into the public data record and the private data record an indicator to indicate that both the private data record and the public data record emanated from the same source.

Ewing teaches to provide access to the private data record from the public data record, said access enabling use of said private data record without providing read

access to said other data in the private record (Ewing, paragraph 0037), including the step of putting into the public data record and the private data record an indicator to indicate that both the private data record and the public data record emanated from the same source (Ewing, paragraph 0047)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the de l'Etraz et al. by teachings of Ewing to include to provide access to the private data record from the public data record, said access enabling use of said private data record without providing read access to the private record), including the step of putting into the public data record and the private data record an indicator to indicate that both the private data record and the public data record emanated from the given person because it maintains the confidentiality and protection of private information (Ewing; paragraph 0052).

de l'Etraz et al. does not teach storing the logical link in both the public data record and the private data record and providing a user with the logical link.

Ewing teaches storing the logical link in both the public data record and the private data record and providing a user with the logical link (Ewing, paragraph 0037, wherein the link is executed when the user executes the search).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the de l'Etraz et al. by teachings of Ewing to storing the logical link in the public data record because the link provides fast and efficient means to request the information.

de l'Etraz does not teach providing a user with a logical link to a private data set, and using that logical link to give that user access to selected data in a private data set, where that selected data enables the user to contact a given person.

Ewing teaches providing a user with a logical link to a private data set, and using that logical link to give that user access to selected data in a private data set, where that selected data enables the user to contact a given person (Ewing Paragraph 47-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the de l'Etraz et al. by teachings of Ewing to provide a user with a logical link to a private data set, and using that logical link to give that user access to selected data in a private data set, where that selected data enables the user to contact a given person because the link provides fast and efficient means to request the information.

As per claim 2 de l'Etraz et al., as modified is directed to the logical link comprises a randomly generated numeric key value stored in the public data record and the private data record, said key value is said indicator, and comprising the further step of providing the user with said key value, and wherein the step of receiving a request from the user includes the step of said user using said value to access the public data record (de l'Etraz et al., column 10, lines 47-65, wherein key value is the ownerID) de l'Etraz et al., column 11, lines 1-4).

As per claim 4 de l'Etraz et al. as modified is directed to the predefined operation comprises analysis of data in a plurality of private data records (de l'Etraz et al., column 5, lines 55-63).

As per claim 5 de l'Etraz et al. as modified is directed to the further step of forwarding the results of the analysis to the user (de l'Etraz et al., column 5, lines 55-63).

As per claim 10 de l'Etraz et al. as modified is directed to the performing the predefined operation step is performed only when a required condition is satisfied (de l'Etraz et al., column 8, lines 44-67).

As per claim 11 de l'Etraz et al. as modified is directed to the required condition is based upon information in the private record (de l'Etraz et al., column 8, lines 50-55).

As per claim 12 de l'Etraz et al. as modified is directed to the private data record comprises data regarding any one of a link ID, a key, a consumer or an enterprise (de l'Etraz et al., column 11, lines 1-4).

As per claim 13 de l'Etraz et al. as modified is directed to the public data record comprises data regarding any one of a link ID, a key, a consumer or a product (de

l'Etraz et al., column 11, lines 1-4).

As per claim 14 de l'Etraz et al. as modified is directed to the performing the predefined operation step comprises the further step of retrieving data from any one of the private data record or the public data record (de l'Etraz et al., column 17, lines 2-13).

As per claim 15 de l'Etraz et al. as modified is directed to forwarding the retrieved data to the user (de l'Etraz et al., column 7, lines 28-31, wherein the data is in the form of web page).

As per claim 46, Examiner notes that the nature of the selected data does not affect the process of selecting the selected data and is therefore considered to be non-functional descriptive material and is given no patentable weight.

5. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (US 6,073,138) in view of Ewing (US 2003/0095298 A1) and further in view of Scroggie et al. (US 6,014,634).

As per claim 6 de l'Etraz et al. as modified still does not teach performing the predefined operation comprises the further steps of:

using information from the private data record as a network address;

Scroggie et al. teaches performing the predefined operation comprises the further steps of: using information from the private data record as a network address (Scroggie et al., column 12, lines 50-53);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include using information from the private data record as a network address because it would allow contact or update between entities (Scroggie et al., column 4, lines 20-30).

de l'Etraz et al. as modified does not teach transmitting a message to the network address.

Scroggie et al. teaches and transmitting a message to the network address (Scroggie et al., column 12, lines 57-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include transmitting a message to the network address because it would make contact or update between entities easier and faster (Scroggie et al., column 4, lines 20-30).

As per claim 7 de l'Etraz et al. as modified still does not teach the message comprises email.

Scroggie et al. teaches the message comprises email (Scroggie et al., column 12, 57-58)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises email because e-mail permits contact between entities in an easy and comfortable way (Scroggie et al., column 4, lines 20-30).

As per claim 8 de l'Etraz et al. as modified still does not teach the message comprises message information from any one of the private data record or the public data record.

Scroggie et al. teaches the message comprises message information from any one of the private data record or the public data record (Scroggie et al., column 12, lines 40-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises message information from any one of the private data record or the public data record because information in the records determine what the message will contain (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

As per claim 9 de l'Etraz et al. as modified still does not teach the message comprises marketing material.

Scroggie et al. teaches the message comprises marketing material (Scroggie et al., column 12, 59-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises marketing material because it makes sense to use the invention in a business environment (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Hicks whose telephone number is (571) 272-2670. The examiner can normally be reached on Monday - Friday 9:00a - 5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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